

REMARKS

The Applicants have thoroughly considered the Official Action dated December 29, 2005 and have prepared this Amendment in response thereto. The Applicant has amended claim 35 to correct the error in dependency noted in the Examiner's objection. No other amendments have been made. The following remarks will follow the order set forth in the Office Action.

Rejections Under 35 USC §103

Claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 23-33 and 35-42 were again rejected as obvious in light of the Barnes reference in further view of the Willner reference. In its "Amendment" filed on October 8, 2005, the Applicants responded to these same rejections by asserting that (1) the Willner reference was not prior art and could not form the basis for an obviousness rejection and (2) the Applicants' claims are unobvious even if the Willner reference were prior art. The Applicants submitted the "Declaration Under 37 CFR§1.131 of Robert Andrew Byers, Jr." (the "Byers Declaration") in support of their assertion that the Willner reference is not prior art and submitted the "Declaration Under 37 CFR§1.132 of Kenneth R. Taylor" (the "Taylor Declaration") in support of their assertion that the claims are unobvious even if the Willner reference were prior art. In responding to the Applicant's arguments, the Examiner asserted that the Byers Declaration was insufficient to overcome the Willner reference and that the Taylor Declaration was insufficient to overcome the obviousness rejections. For the reasons set forth below, the Applicant respectfully disagrees with these assertions.

1. The Willner reference is not prior art

37 CFR 1.131 states, in pertinent part:

“(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based....

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.”

The Applicants assert that the Byers Declaration, on its face, satisfies each of these requirements; i.e. it was made by an inventor of the subject matter of all claims, includes photocopies of original exhibits as part of the declaration, and swears to facts sufficient to establish both conception and reduction to practice of the claimed invention prior to the effective date of the Willner reference.

The Examiner asserted that “(t)he declaration does not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date” and that “Applicants must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by the applicant”. The Applicants respectfully disagree that the declaration is vague, but have provided the further explanation requested by the Examiner.

Mr. Byers declared that the ““Website Rewrite Proposal”, dated June 3, 1999, and denoted as Exhibit A, is a true copy of what it purport to be and *is evidence of prior conception* of the subject matter claimed in the above referenced patent application”. (Emphasis added). The Website Rewrite Proposal is a document that was prepared by the

firm contacted by they Applicants for the purpose of reducing the Applicants' invention to practice in the form of a website. The proposal sets forth, in great detail, the features that were conceived of as of the date of the proposal and relayed to the firm for the purpose of securing their services. Exhibit A is evidence of conception of the invention because the novel and unobvious features of the Applicants' invention are set forth therein.

The Byers Declaration also shows sufficient facts to establish reduction to practice of the invention. In particular, Mr. Byers declared that the "attached printout from a test order, denoted "Welcome, Salina Regional Health Center, to e-QuickTM" dated March 7, 2000, and denoted as Exhibit B, is a true copy of what it purport to be and *is evidence of prior reduction to practice* of the subject matter claimed in the above referenced patent application" and "the computer program product and system embodied in the website that generated the order attached as Exhibit B, included all of the subject matter claimed in the above referenced patent application, and that this website was completed at least as early as March 7, 2000." The printout shown in Exhibit B is a test order for an actual customer that was created using the computer program product and system embodied in the website created pursuant to the proposal presented as Exhibit A. The printout shows all of the products sold to that particular customer within a specified time period, the customer's specific price, and a quantity entry field, which is the only field in which data entry is required in order for the customer to purchase a given product.

It is clear from the foregoing that the attached Exhibits show that the Applicants conceived of their invention, obtained a proposal for that invention to be reduced to practice in the form of a website, and that the website that was developed pursuant to the proposal was, in fact, reduced to practice as of at least March 7, 2000.

Finally, it is noted that Mr. Byers has declared that the website shown in Exhibit B included all of the subject matter claimed in the present application and that “all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true”.

For the reasons set forth above, the Applicants assert that the Byers Declaration meets the requirements of 37 CFR §1.131 and is sufficient to establish invention of the subject matter of all rejected claims prior to the effective date of the Willner reference. Accordingly, the Applicants again assert that the Willner reference is not prior art and respectfully request that all rejections based upon the Willner reference be reconsidered and withdrawn.

2. *The Applicants' claims are unobvious even if the Willner reference were prior art.*

The Applicants submitted the Taylor Declaration in support of their assertion that the claims were unobvious even if the Willner reference were prior art. In response, the Examiner asserted that Mr. Taylor “only offers an opinion that the claims are patentable”, that he “offers opinions that are legal conclusion, which are not entitled to any weight” and that “the Declaration was found not to be persuasive because of a lack of factual support”. The Applicants respectfully disagree with each of these assertions.

First, nowhere within the Taylor Declaration does Mr. Taylor provide any opinion that the claims are patentable.

Second, although the Applicants admit that paragraph 9 of the Taylor Declaration makes the legal conclusion that the claims are not obvious, the remainder of the Taylor Declaration does not include any legal conclusions. Rather, Mr. Taylor makes declarations that rebut the establishment of a prima facie case of obviousness and show that the secondary factors relevant to the obviousness determination also weigh against a finding of obviousness.

Further, Mr. Taylor provides a detailed explanation of the reasons underlying these declarations.

With regard to the factors for establishing a prima facie case of obviousness, Mr. Taylor declared in paragraph 5 “that the Barnes reference does not disclose or suggest a user specific purchase history form comprising all products that were purchased during a specified time period, as claimed in each of the applicants’ claims”. In paragraph 6, Mr. Taylor declared that he “would not be motivated to modify the Barnes reference to include the user specific purchase history form claimed by the applicant”. In paragraph 7, Mr. Taylor declared that he “would not be motivated to combine the Barnes and Willner references cited by the Examiner to obtain a system including a user specific order entry form where a quantity entry field is the only fields in which entry of data by the user is required to purchase a product” and “that such a combination would not result in a method system or computer product that provides the advantages of the applicant's invention.” In paragraph 8, Mr. Taylor declares that “the Willner reference teaches away from the use of the claimed user specific order entry form”, which relates directly to the suggestion or motivation to combine the references. None of these declarations are legal conclusions, each directly rebuts a factor required to establish a prima facie case of obviousness, and each should have been accorded proper weight.

With regard to the secondary considerations, Mr. Taylor declared in paragraph 9 that a “specific purchase history form in which a quantity entry field is the only field in which a user is required to enter data provides distinct advantages over current systems and, consequently, it is my belief that the applicants have identified and solved a problem that has heretofore gone unrecognized”. Mr. Taylor also stated that “(i)t is likewise my belief that such a system would be in widespread use by this time if the problem solved thereby were recognized.”

These declarations are likewise not legal conclusions and should have been given proper weight.

Finally, regarding the assertion that the declaration lacked factual support, Mr. Taylor declared that he “is one of one of at least ordinary skill in the arts of software design and programming, including the design and programming of methods and systems for selling products over computer networks” and that he “read the above referenced patent application, including the claims as currently amended, the Official Actions dated October 6, 2004 and March 31, 2005, the applicants’ amendment dated January 6, 2005, and the Barnes and Willner references cited by the Examiner”. Accordingly, the factual support for his declarations encompassed all of the relevant documents and his knowledge as one of skill in the relevant art.

For the reasons set forth above, and those set forth in the “Amendment” filed on October 8, 2005, the Applicants assert that claims 1-2, 5, 8-9, 15-16, 18-19, 21-30, 23-33 and 35-42 are unobvious. Accordingly, the Applicants respectfully request that the Examiner reconsider these rejections in light of Declarations submitted and the remarks, both herein and previously presented, and allow all pending claims.

Requirement for Information under 37 CFR 1.105

The Examiner requested that Applicant provide the relationship of Kenneth R. Taylor to the inventors and assignee. The Applicant states that Mr. Taylor has no relationship, either personal or professional, with any of the inventors or the assignee.

Conclusion

It is felt that a full and complete response has been made to the Official Action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully

requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, the Examiner is invited to phone the Applicants' attorney at the number set forth below.

Respectfully submitted,



Date: May 30, 2006

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